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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,881	08/06/2001	Brian K. Balzum	1001.1403101	6196
28075	7590	10/28/2004	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			NGUYEN, VI X	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/925,881	<b>Applicant(s)</b> BALZUM ET AL.	
	<b>Examiner</b> Victor X Nguyen	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 25, 30-31 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan (U.S. 5,234,002).

2. Chan discloses in figure 2, col. 3, lines 1-35 and lines 50-65, a threaded connection system is suitable for use in connecting extension wires and guidewire having the limitations of claims 25 and 34, including: a first wire (10) includes a body member. A female threaded member (18) disposes within the first end of the body member. A second wire (11) includes a second body member (17). An engagement structure (15) adapts to threadingly engaging the female thread of the first wire. The engagement structure is a male thread disposed about the body member of the second wire; and wherein a portion of the male thread of the first wire is adapted to deform or capable of altering the shape by pressure when the male thread threadingly engages the female thread of the first wire (as best seen in fig. 2). Regarding the intended use of the male thread of the first wire is adapted to deform, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the male thread of Chan would have been capable of performing the use as claimed. In a

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claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3. Regarding claims 30-31, Chan discloses in figure 2, col. 3, lines 1-35 and lines 50-65, a threaded connection system is suitable for use in connecting extension wires and guidewire having the limitations of claims 25 and 34, including: a first wire (10) includes a body member. A female threaded member (18) disposes within the first end of the body member. A second wire (11) includes a second body member (17). An engagement structure (15) adapts to threadingly engaging the female thread of the first wire. The engagement structure is a male thread disposed about the body member of the second wire; and wherein a portion of the male thread of the first wire is adapted to be more deformable or capable of altering the shape by pressure when the male thread threadingly engages the female thread of the first wire. Furthermore, the portion of the male thread includes two portions that are different from one another (see col. 3, lines 50-65). Regarding the intended use of the male thread of the first wire is adapted to be more deformable, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the male thread of Chan would have been capable of performing the use as claimed. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan.

(U.S. 5,234,002).

Regarding claims 32-33, Chan discloses substantially limitations as recited in the claims. The system of Chan could be made a second portion of the male thread that comprises a different thread pitch or a different thread size. It has been held that changes in size only require routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the thread of Chan device with a different thread pitch and a different thread size in order to have an effectively grip in connecting a guidewire and an extension wire.

***Response to Amendment***

5. Applicant's arguments with respect to claims 25, 30 and 34 have been considered but they are not persuasive. With respect to claim 25, the examiner disagrees with applicant's remarks that the Chan reference fails to disclose that the guide wire has female thread, where the extension wire includes an engagement structure and where a portion of the male thread of the first wire is adapted to deform when the male thread threadingly engages the female thread of the first wire. As the examiner has pointed out above, Chan discloses in figure 2, col. 3, lines 1-35

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and lines 50-65, a threaded connection system is suitable for use in connecting extension wires and guidewire having the limitations including: a first wire (10) includes a body member. A female threaded member (18) disposes within the first end of the body member. A second wire (11) includes a second body member (17). An engagement structure (15) adapts to threadingly engaging the female thread of the first wire. The engagement structure is a male thread disposed about the body member of the second wire; and wherein a portion of the male thread of the first wire is adapted to deform or capable of altering the shape by pressure when the male thread threadingly engages the female thread of the first wire (as best seen in fig. 2). Regarding the intended use of the male thread of the first wire is adapted to deform, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the male thread of Chan would have been capable of performing the use as claimed. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, claim 25 of the invention is not defined over the Chan reference.

### ***Conclusion***

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn *VP*  
10/25/2004

*Julian W. Woo*

JULIAN W. WOO  
PRIMARY EXAMINER